

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

ASTELLAS INSTITUTE FOR
REGENERATIVE MEDICINE,

Plaintiff,

v.

IMSTEM BIOTECHNOLOGY, INC.,
XIAOFANG WANG, and REN-HE XU,

Defendants.

C.A. NO. 1:17-cv-12239-ADB

**JOINT STIPULATION AND [PROPOSED] ORDER REGARDING PATENTS
AND APPLICATIONS RELATED TO THE '551 AND '122 PATENTS AND
JOINT REQUEST FOR PARTIAL STAY OF JUDGMENT PENDING APPEAL**

Plaintiff Astellas Institute for Regenerative Medicine (“Astellas”) and Defendants ImStem Biotechnology, Inc. (“ImStem”), Xiaofang Wang, and Ren-He Xu (collectively, “Defendants” or “ImStem”)) file this Joint Stipulation regarding patents and patent applications related to U.S. Patent Nos. 9,745,551 (“the ’551 patent”) and 10,557,122 (“the ’122 patent”), and Joint Request for a partial stay of the Court’s March 20, 2022 judgment pending appeal.

Whereas the Court entered judgment on March 10, 2022 in favor of Astellas and against Defendants as to the claims, *inter alia*, for (Count 1) Correction of Inventorship of United States Patent No. 9,745,551, which included the parties’ earlier stipulation that any judgment on the ’551 patent would be binding on U.S. Patent No. 10,557,122; (Counterclaim 1) Correction of Inventorship of United States Patent No. 8,961,956 (“the ’956 patent”); and (Counterclaim 2) Correction of Inventorship of United States Patent No. 8,962,321 (“the ’321 patent”) (collectively “the inventorship claims”) [ECF No. 280];

Whereas the Court ordered the Director of the United States Patent and Trademark Office to add Robert Lanza and Erin Kimbrel as inventors on the '551 patent and the '122 patent and to remove Xiaofang Wang and Ren-He Xu as inventors on those patents, and further ordered Defendants to cooperate with Astellas to effectuate the change in inventorship of the '551 and '122 patents, including executing or filing any necessary Petitions to Correct Inventorship or assignments [ECF No. 280];

Whereas the Court denied Astellas' request that Defendants be required to: 1) assist in the transfer of ownership of the '551 and '122 patents; 2) correct the inventorship and assist in any corresponding correction of ownership of a) PCT/US2013/048291 (the "'551 PCT application"), to which the '551 patent claims priority; b) any foreign patents or applications that claim priority to the '551 PCT application, which include applications and issued patents in China and Canada and a pending application in Hong Kong (*i.e.*, including patents and application nos. CA2876499A1, CA2876499C, CN104471059A, CN104471059B, HK1208054A1, WO2014/011407A2, and WO2014/011407A3); and (3) any other pending U.S. patent applications that claim priority to the '551 PCT application, which include U.S. Patent Application No. 16/745,944 (the "'944 application"), *see* [ECF No. 279];

Whereas the Court in its March 10, 2022 Judgment determined Astellas to be the prevailing party under Fed. R. Civ. P. 54(d) and stated that Astellas "may within 30 days move to demonstrate entitlement to attorneys' fees under Fed. R. Civ. P. 54" [ECF No. 280];

Whereas Defendants intend to appeal the Court's judgment; and

Whereas the Parties wish to eliminate the need to litigate the issues of (1) whether the judgment should be stayed pending appeal; and (2) Astellas' entitlement to attorneys' fees;

The Parties hereby stipulate and agree to the following:

1) Astellas hereby waives its right to move for attorneys' fees pursuant to the March 10, 2022 Judgment under Fed. R. Civ. P. 54, 35 USC § 285, or any other provision of law;

2) The Court should stay its judgment pending appeal pursuant to Fed. R. Civ. P. 62 insofar as the judgment orders the Director of the United States Patent and Trademark Office to add Robert Lanza and Erin Kimbrel as inventors on the '551 patent and the '122 patent and to remove Xiaofang Wang and Ren-He Xu as inventors and further orders Defendants to cooperate with Astellas to effectuate the change in inventorship of the '551 and '122 patents at ECF No. 280 pending resolution of Defendants' appeal to the Federal Circuit; and

3) In the event and to the extent that Astellas prevails on inventorship at the Federal Circuit with respect to the '551 and '122 patents, Defendants shall: a) assist, to the extent needed, in the transfer of ownership of the '551 and '122 patents; b) correct the inventorship (by adding Drs. Lanza and Kimbrel and/or removing Drs. Wang and Xu, depending upon the specifics of the Federal Circuit's ruling) and assist in any corresponding correction of inventorship and ownership of (A) PCT/US2013/048291 (the "'551 PCT application"), to which the '551 patent claims priority; (B) any foreign patents or applications that claim priority to the '551 PCT application, which include applications and issued patents in China and Canada and a pending application in Hong Kong (*i.e.*, including patents and application nos. CA2876499A1, CA2876499C, CN104471059A, CN104471059B, HK1208054A1, WO2014/011407A2, and WO2014/011407A3); and (C) any other pending U.S. patent applications that claim priority to the '551 PCT application, which include U.S. Patent Application No. 16/745,944 (the "'944 application").

SO ORDERED:

Dated: April __, 2022

Allison D. Burroughs
United States District Judge

Dated: April 8, 2022

Respectfully submitted,

/s/ David P. Frazier

Charles H. Sanders (BBO# 646740)
LATHAM & WATKINS LLP
John Hancock Tower, 27th Floor
200 Clarendon Street
Boston, MA 02116
Telephone: (617) 948-6022
Facsimile: (617) 948-6001
charles.sanders@lw.com

Michael A. Morin (*pro hac vice*)
David P. Frazier (*pro hac vice*)
Rebecca L. Rabenstein (*pro hac vice*)
LATHAM & WATKINS LLP
555 Eleventh Street, NW, Suite 1000
Washington, DC 20004
Telephone: (202) 637-2200
Facsimile: (202) 637-2201
michael.morin@lw.com
david.frazier@lw.com
rebecca.rabenstein@lw.com

Brenda L. Danek (*pro hac vice*)
LATHAM & WATKINS LLP
330 North Wabash Avenue, Suite 2800
Chicago, IL 60607
Telephone: (312) 876-7700
Facsimile: (312) 993-9767
brenda.danek@lw.com

Yi Sun (*pro hac vice*)
LATHAM & WATKINS LLP
12670 High Bluff Drive
San Diego, CA 92130
Telephone: (858) 523-5400
Facsimile: (858) 523-5450
yi.sun@lw.com

*Counsel for Plaintiff Astellas Institute for
Regenerative Medicine*

/s/ Sanford I. Weisburst

Sanford I. Weisburst (*pro hac vice*)
Nicola R. Felice (*pro hac vice*)
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Ave., 22nd Floor
New York, New York 10010
Telephone: (212) 849-7000
Facsimile: (212) 849-7100
sandyweisburst@quinnemanuel.com
nicolafelice@quinnemanuel.com

Martha C. Gaythwaite, MA Bar # 187650
VERRILL DANA LLP
One Portland Square
Portland, Maine 04101
(207) 774-4000
mgaythwaite@verrill-law.com

Travis K. Waller (*pro hac vice*)
VERRILL DANA LLP
355 Riverside Avenue
Westport, CT 06880
(203) 222-3119
twaller@verrill-law.com

*Counsel for Defendants ImStem Biotechnology,
Inc., Xiaofang Wang, and Ren-He Xu*

CERTIFICATE OF SERVICE

I hereby certify that this document, which was filed with the Court through the CM/ECF system, will be sent electronically to all registered participants as identified on the Notice of Electronic Filing, and paper copies will be sent via first class mail on April 8, 2022 to those identified as non-registered participants.

/s/ David P. Frazier
David P. Frazier